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In re Application of :
Richard W. Voellmy :
Serial No.: 09/939,161 : PETITION DECISION
Filed: August 24, 2001 :
Attorney Docket No.: MDH-100XCIT :

This is in response to the petition under 37 CFR 1.181, filed July 26, 2006, requesting withdrawal of the Final rejection.

BACKGROUND

A review of the file history shows that applicant filed this application on August 24, 2001, with claims 1-22. The examiner mailed a restriction requirement to applicant on October 01, 2002. Applicant responded on November 18, 2002, electing the species of the chemical inducer of the stress protein response that is an arsenic salt and also requesting the examiner to add other species for the method claims.

The examiner mailed a non-final Office action to applicant on February 26, 2003, in which he:
Withdrew the restriction requirement;
Rejected claims 1, 10, 16, 17 and 20 under 35 U.S.C. 102(b) over Li et al USP 5,830,177;
Rejected claims 1-22 under 35 U.S.C. 103(a) over Li et al in view of Jimenez et al US 5,486,509.

Applicant responded with 5 pages of argument on May 12, 2003.

The examiner mailed another non-final Office action to applicant on August 12, 2003 in which he:
Rejected claims 1-15, 21 and 22 under 35 USC 112 first paragraph for the first time;
Withdrew the 35 U.S.C. 102 rejection of claims 1, 10, 16, 17 and 20, over Li et al; and
Maintained the 35 U.S.C. 103 rejection of claims 1-22 over Li et al. in view of Jimenez et al.

Applicant responded with 10 pages of argument, on January 20, 2004.

The examiner mailed a Final Office action to applicant on May 06, 2004, in which he:

Maintained the rejection of claims 1-15, 21 and 22 under 35 U.S.C. 112, first paragraph; and also
Maintained the 35 U.S.C. 103 rejection of claims 1-22 over Li et al. in view of Jimenez et al; and
Responded to the arguments and made the action final.

On September 23, 2004 applicant filed RCE papers canceling claims 1-15 and 21-22 and adding new claims 23-25, and presented a proper reply to the rejections of record. Canceling claims 1-15 and 21-22 overcame the 35 U.S.C. 112 rejection. Applicant further argued the 35 U.S. C. 103 rejection.

The examiner mailed a non-final Office action to applicant on October 05, 2004, in which he:
Withdrew the 35 U.S.C. 112 rejection as applicant had cancelled the claims;
Withdrew the 35 U.S.C. 103 rejection of claims 1-15 and 21 and 22 as applicant had canceled the claims;
Maintained the rejection of claims 16-20 under 35 U. S.C. 103 over Li et al in view of Jimenez et al; and
Rejected new claims 23-25 under 35 U.S.C. 103 over Li et al (USP 5,830,177) in view of Jimenez et al (USP 5,486,509).

Applicant responded on March 31, 2005, canceling claims 16-20 and 23-25 and adding new claims 26-33. Applicant also presented argument to overcome the 35 U.S.C. 103 rejection.

The examiner mailed a non final Office action to applicant on October 07, 2005, in which he:
Rejected new claims 26-33 under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph;
Withdrew the rejection of claims 16-20 and 23-25 under 35 U.S.C. 103 over Li et al. in view of Jimenez et al. since applicant had cancelled the claims.

Applicants responded with arguments on March 09, 2006, to overcome the 35 U.S. C. 101 and 35 U.S. C. 112, first paragraph rejections.

The examiner mailed a final Office action to applicant on June 01, 2006, in which he maintained the previous 35 U.S.C. 112 and 101 rejections and made the action Final.

In response applicants filed this petition on July 26, 2006, seeking withdrawal of the finality of the Office action.

DISCUSSION

Applicant argues that the Final Office action was premature or improper; therefore the finality should be withdrawn. Applicant submits that new grounds of rejections were articulated in the Office action and that these new grounds of rejections were neither necessitated by applicant's amendment nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Applicant states that, the Office has provided a new interpretation of the claims that was not set forth in the

previous Office action and applicant was not afforded an opportunity to address the issues articulated by the examiner.

Upon review of the file history, as given above, it is noted that the examiner made new grounds of rejection in the Office action mailed October 07, 2005. He did not make the action final even though the rejections were made on newly added claims. Applicants were given a chance to respond to the new rejections. In the final Office action mailed June 01, 2006 the examiner responded to applicant's arguments pointing out why the rejections were being maintained in view of the scope of the claims. The rejections did not change. The "alleged" new arguments were merely an explanation as to why the claim scope justified the rejection of record and applicant's arguments failed to overcome the rejection. Thus finality of the Office action was appropriate.

DECISION

The petition to withdraw the finality is **DENIED**.

Applicant remains under obligation to file a proper response to the Final Office action mailed June 1, 2006, within the time period set therein, or as extended under 37 CFR 1.136(a).

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.



Bruce M. Kisliuk
Director, Technology Center 1600
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